

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks are respectfully requested.

Claim Status

As is correctly reflected in the Office Action Summary, Claims 1, 2, 7-20, and 23-25 are pending. Claims 1, 2, and 7-18 have been withdrawn from consideration. Claims 20 and 23 are allowed, and Claims 19, 24, and 25 stand rejected.

Summary of Amendments

By the foregoing amendments, Claim 19 was amended to specify that expression of the nucleotide sequence encoding the amino acid of SEQ ID NO:1 *in a transgenic plant* is induced by osmotic stress and renders said transgenic plant resistant to said osmotic stress. Support for this amendment may be found at least at Paragraphs 0010 and 0011 of the Specification. Accordingly, no new matter has been added.

Also by the foregoing amendments, Claim 20 was amended to correct a minor and typographic error. No new matter has been added.

Next, Claim 24 was amended in part (a) to specify that the no more five additions, deletions, or substitutions do not occur between nucleotides 132 and 155 of SEQ ID NO:3. Support for this amendment may be found at least in the combination of information contained in Figures 1 and 3 and in Paragraphs 0036 and 0037 of the Specification. Accordingly, no new matter has been added.

Also by the foregoing amendments, Part (a) of Claim 24 was amended to clarify that expression of said nucleotide sequence in a transgenic plant is induced by osmotic stress and renders said transgenic plant resistant to said osmotic stress. Support for this amendment may be found at least at Paragraphs 0008 and 0010-0011 of the Specification. Accordingly, no new matter has been added.

Part (b) of Claim 24 was amended to clarify that an isolated nucleotide sequence exhibiting at least 80% *sequence* homology with isolated nucleotides 1-1210 of SEQ ID NO:3 of Claim 23 wherein expression of said nucleotide sequence *in a transgenic plant* is induced by osmotic stress and renders said transgenic plant resistant to said osmotic stress is claimed. Support for this amendment may be found at least at Paragraphs 0008 and 0010-0011 of the Specification. Accordingly, no new matter has been added.

Finally by the foregoing amendments, Claim 25 was amended to specify parameters of "stringent conditions." Support for this amendment may be found at least at Paragraph 0008 of the Specification. Accordingly, no new matter has been added.

Rejection Under 35 U.S.C. § 112, First Paragraph — Enablement

Claim 24 has been rejected under 35 U.S.C. § 112, First Paragraph, as purportedly not enabled. *See Official Action, Pages 2-4.* This rejection is respectfully traversed.

A disclosure is enabling even if a considerable amount of experimentation is involved, so long as the experimentation is merely routine. *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1564 (Fed. Cir. 1996) (quoting *Ex parte Jackson*, 217 U.S.P.Q. 804, 807 (B.P.A.I. 1982)). Applicants maintain that making no more than 5

additions, deletions, or substitutions to SEQ ID NO:3 is merely routine. Applicants also maintain that it is routine to determine whether expression of altered SEQ ID NO:3 in a transgenic plant is induced by osmotic stress and renders said plant resistant to said osmotic stress.

However, not to acquiesce in the Examiner's rejection, but solely to facilitate prosecution, Claim 24 has been amended to specify that the no more than five additions, deletions, or substitutions may not occur between nucleotides 132 and 155 (corresponding to amino acids 37 to 44 of the encoded polypeptide) of SEQ ID NO:3. This prohibition is based upon scientific estimations based upon conserved sequences among plant species. *See Figures 1 and 3 and Paragraphs 0036 and 0037 of the Specification.* Applicants maintain that this amendment reduces the amount of routine experimentation potentially called for by Claim 24.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, First Paragraph, enablement rejection of Claim 24.

Rejection Under 35 U.S.C. § 112, Second Paragraph — Indefiniteness

Claims 19, 24, and 25 were rejected under 35 U.S.C. § 112, Second Paragraph, as allegedly indefinite. *See Official Action, Pages 4-5.* This rejection is respectfully traversed.

Not to acquiesce in the Examiner's rejection, but solely to facilitate prosecution, Applicants have amended Claims 19 and 24, as suggested by the Examiner, to specify that expression of the nucleotide sequence occurs in a transgenic plant and to recite not "a"

transgenic plant later in the claim, but "said" transgenic plant. Claim 24 was also amended to specify that it is 80% sequence homology that is required. Claim 25 has been amended to include several stringent hybridization conditions.

Applicants believe these amendments have rendered moot the outstanding indefiniteness rejections. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, Second Paragraph, indefiniteness rejection of Claims 19, 24, and 25.

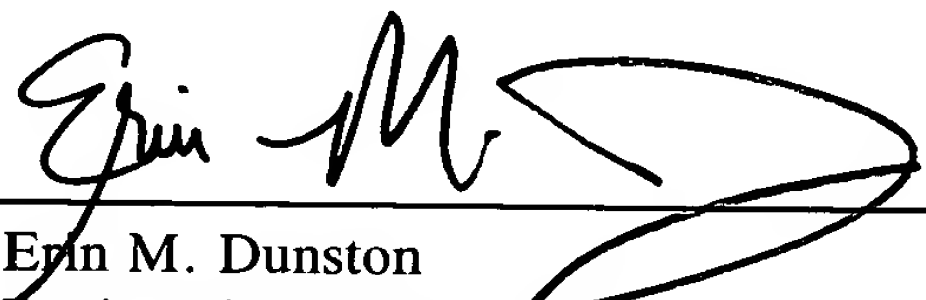
CONCLUSION

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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